

REMARKS

Claims 2, 4-5, 7-8, 10-12, 15-16, 18-29, and 41-71 were previously pending in this Application. Claims 1, 3, 6, 9, 13-14, 17 and 30-40 were canceled previously. Claims 10-11 are withdrawn from consideration by the Examiner at this time. By the present Amendment, claim 2 and 7 are amended, and claims 28-29 are canceled. Withdrawn claims 10-11, and claims 58-65 and 70-71, dependent therefrom, are also canceled. Applicant submits that no new matter has been added to the Application by these amendments. Applicant reserves the right to pursue subject matter canceled from this case in a future application that claims priority to the present Application. Thus, claims 2, 4-5, 7-8, 12, 15-16, 18-27, 41-57 and 66-69 are pending and under consideration by the Examiner.

Each of the rejections levied by the Examiner in the outstanding Office Action is addressed in turn below.

1. Claim Amendments in light of the Restriction Requirement

In the Response to the Restriction Requirement set forth in the Office Action mailed June 30, 2010, Applicants elected Group I, drawn to compounds and methods of use wherein A" is benzo or cyclohexyl. Accordingly, Applicant has amended the definition of A" in claim 2 to be "a fused benzene ring" or "a fused cyclohexene ring, wherein the ring is fully saturated except for the bond where the ring is fused." Support for these amendments is provided in the definition of "fused aryl ring" on page 52, lines 1-3, of the Specification as originally filed; and the definition of "fused 5 to 7 membered saturated ring" on page 52, lines 9-11, of the Specification as originally filed.

Applicant has canceled claims 10-11, and claims 58-65 and 70-71, dependent therefrom, directed to non-elected subject matter.

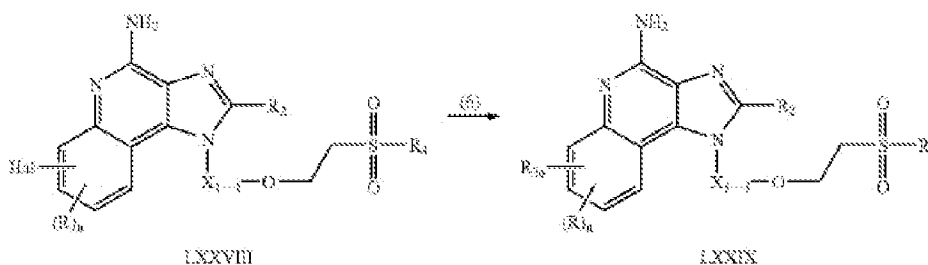
2. Rejection under 35 U.S.C. § 112, first paragraph

Claims 28-29 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Without conceding the Examiner's argument and solely to advance prosecution, Applicant has canceled claims 28-29. The rejection of claims 28-29 is therefore rendered moot.

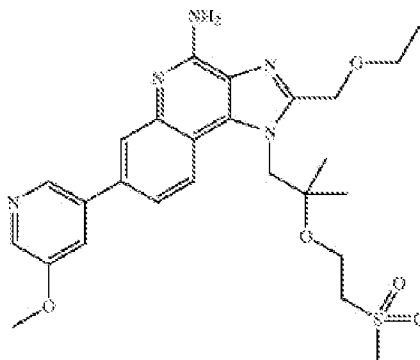
3. *Rejection under 35 U.S.C. § 102 (e)*

Claims 2, 4-5, 7-8, 12, 15-16, 18-29 and 41-71 stand rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent No. 7,091,214 (hereafter "Hays"). Specifically, the Examiner points to the generic formulae LXXVIII and LXXIX, provided at column 43-44 of Hays, and the compound of Example 364, provided at column 196 of Hays, as anticipating the presently claimed invention. Applicant disagrees.

LXXVIII and LXXIX, column 43-44, of Hays:



Compound of Example 364, column 196, of Hays:



As an initial matter, in the present Amendment, Applicant has canceled claims 28-29, 58-65 and 70-71. Thus, only independent claims 2, 4-5, 7-8, 26-27, and 66-69, and claims 12, 15-16, 18-25 and 41-57, dependent therefrom, stand rejected under §102 (e) in view of Hays.

Applicant submits that neither formula LXXVIII, formula LXXIX, nor the compound of Example 364 of Hays teaches a compound containing a fused cyclohexene ring, *i.e.*, a compound of

Formula Ia wherein A" is a fused cyclohexene ring, or a compound of Formula IIIa, as provided in independent claims 2, 7-8, 68, and 69.

Applicant further submits that neither formula LXXVIII, formula LXXIX, nor the compound of Example 364 of Hays teaches a compound of Formula Ia wherein A" is a fused benzene ring, or a compound of Formula IIa (*i.e.*, as provided in independent claims 2, 4, 5, 66, and 67).

For example, "Hal" of formula LXXVIII of Hays is defined as bromo, chloro, or iodo (see column 21, line 43, of Hays). In contrast, "R" of Formulae Ia and IIa is selected from the group consisting of alkyl, alkoxy, hydroxyl, fluoro, and trifluoromethyl. "R" cannot be bromo, chloro, or iodo.

Furthermore, "R_{3a}" of formula LXXIX of Hays is defined as -Z_a-Ar, -Z_a-Ar'-Y-R₄, or Z_a-Ar'-X-Y-R₄, wherein Ar is aryl or heteroaryl, and Ar' is arylene or heteroarylene (see column 21, lines 41-43 and column 5, lines 62-63, and column 6, lines 4-5 of Hays). In contrast, "R" of Formulae Ia and IIa is selected from the group consisting of alkyl, alkoxy, hydroxyl, fluoro, and trifluoromethyl. "R" cannot be aryl, heteroaryl, arylene, or heteroarylene.

Moreover, the compound of Example 364 is substituted with a heteroaryl group (*i.e.*, pyridyl). In contrast, "R" of Formulae Ia and IIa is selected from the group consisting of alkyl, alkoxy, hydroxyl, fluoro, and trifluoromethyl. "R" cannot be heteroaryl.

In light of the above remarks, Applicant submits that since Hays does not teach each and every element of independent claims 2, 4-5, 7-8, 26-27 and 66-69, Hays does not anticipate the claimed invention. Applicant respectfully requests that the rejection of claims 2, 4-5, 7-8, 12, 15-16, 18-27, 41-57 and 66-69 under § 102(e) be withdrawn.

As a final matter, if the Examiner is inclined to reject pending claims 2, 4-5, 7-8, 12, 15-16, 18-27, 41-57, and 66-69 under 35 U.S.C. § 103(a), Applicant would like to point out that the present Application and Hays were, at the time the claimed invention in the present Application was made, both owned by 3M Innovative Properties Company. Since Hays is prior art with respect to the present Application only under § 102(e), and the present Application and Hays were commonly owned at the time the claimed invention was made, Applicants respectfully submit that, pursuant to § 103(c), Hays "should not preclude patentability" of the present claims under § 103.

In view of the above Amendment and Remarks, Applicant believes the pending Application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge it to our Deposit Account No. 23/2825, under Docket No. C1271.70039US01, from which the undersigned is authorized to draw.

Dated: November 30, 2010

Respectfully submitted,

By /C. Hunter Baker/
C. Hunter Baker, M.D., Ph.D.
Registration Number: 46,533
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210-2206
617.646.8000